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10/578,859	05/11/2006	Jun Kitahara	09812.0129	3333
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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413				VAUGHAN, MICHAEL R
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/578,859	KITAHARA ET AL.	
	Examiner	Art Unit	
	MICHAEL R. VAUGHAN	2431	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 11/25/08.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-9 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-9 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5) Notice of Informal Patent Application

6) Other: _____.

DETAILED ACTION

The instant application having Application No. 10/578,859 is presented for examination by the examiner. Claims 1-8 have been amended; claim 9 has been added. Claims 1-9 are pending.

Claim Objections

Claims objections have been withdrawn by amending the claims.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 and 7 are rejected under 35 U.S.C. 101 based on Supreme Court precedent and recent Federal Circuit decisions, a 35 U.S.C § 101 process must (1) be tied to a particular machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *In re Bilski et al*, 88 USPQ 2d 1385 CAFC (2008); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory

process, the claim should positively recite the particular machine to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps are not tied to a particular machine and do not perform a transformation. Thus, the claims are non-statutory.

The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101.

Note the Board of Patent Appeals Informative Opinion Ex parte Langemyer et al.

Claim 8 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed subject matter fails to squarely fall within one of the statutory classes of invention. The first half of the preamble is directed to computer readable medium containing instructions. The second limitation of the preamble then changes the focus to "the method". The claim cannot be classified as a process or a manufacture.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-6, 8, and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claim 1, “a utilization condition” is defined twice.

As per claim 2, “the plurality of contents” is undefined. This term appears to refer to “a plurality of available contents” but does not definitively make the connection. Also, “the apparatus” in the last line of the preamble now lacks antecedent basis. Dependent claim 3-6 and 9 are likewise rejected.

As per claim 8, the method is undefined. Appropriate correction is required.

As per claim 9, is indefinite because it defines “a second license” for a second time. A second license is defined in claim 2. Further adding to the confusion, is the limitation which states the second content is outputted when the first license and the second license **of the second content** are satisfied. This makes it seem like the second license defined in claim 9 is actually a third license, but Examiner cannot positively ascertain the scope.

Response to Arguments

Applicant's arguments with respect to claims 1-9 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over USP 7,739,548 to Revital et al, hereinafter Revital in view of USP Application Publication 2002/0001386 to Akiyama.

As per claim 1, Revital teaches a method of managing licenses used in a contents distribution service having a channel for distributing a plurality of available content (col. 10, lines 5-7), the method comprising:

transmitting, to an information processing apparatus [recipient module] which accepts an offer of contents, a first license [first layer] having a utilization condition [access to protected content] for the plurality of available content, the first license further including first key information (col. 5, lines 5-7 and col. 10, lines 10-15);

transmitting, to the information processing apparatus, along with a content from among the plurality of available contents, a second license [second layer] which prescribes, in a manner different from transmitting the first license, utilization condition [assess to particular items or portions] for the transmitted content (col. 5, lines 9-10);

wherein, when the utilization condition of the first license and the utilization condition prescribed by the second license are both satisfied, the transmitted contents is permitted to be utilized at the information processing apparatus [properly decrypted] (col. 5, lines 35-37).

Revital is silent in explicitly disclosing the first license has a digital signature and that second license further includes identification information of a first license corresponding to the second license, second key information, and an electronic signature. Akiyama teaches using digital signatures to secure the transportation of licenses (0107). Akiyama goes on to teach why using digital signature secures a transaction from alteration (0113). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine this feature to the licenses of Revital to ensure the licenses are not altered. Akiyama teaches a system whereby a first control information [first license] can be updated by a second control information [second license] which includes identifying information of the first license in order to update it as needed. Akiyama's second control information includes an identifier which specifies the first license and its information. It specifies the first license, so that it can be used to replace certain elements of the first license (0103). Specifically it can change permissions of the subscriber and the decryption keys. Akiyama system also allows for the updating of license information over an out of band channel to greater increase the systems security. Substituting known methods into similar system which yield predictable results if within the ordinary capabilities of the one of ordinary skill in the art. Using out of band updates to licenses improves the security of the system and

integrates well with Revital's system. Revital teaches remotely renewing security elements without the need for physical proximity. Sending the renewable security elements through a phone line is one way of performing this feature without the need to a physical security element proximate to the receiver.

As per claim 2, Revital teaches an information processing apparatus adapted for managing licenses used in a contents distribution service having a channel for distributing a plurality of available content (col. 10, lines 5-7), the apparatus comprising:

first acquisition means for acquiring a first license [first layer] having a utilization condition [access to protected content] for the plurality of available content, the first license further including first key information (col. 5, lines 5-7 and col. 10, lines 10-15);

second acquisition means for acquiring, along with a content from among the plurality of available contents, a second license [second layer] which prescribes, in a manner different from transmitting the first license, utilization condition [assess to particular items or portions] for the transmitted content (col. 5, lines 9-10);

control means for controlling output of the acquired content when the utilization condition of the first license and the utilization condition prescribed by the second license are both satisfied, the transmitted contents is permitted to be utilized at the information processing apparatus [properly decrypted] (col. 5, lines 35-37).

Revital is silent in explicitly disclosing the first license has a digital signature and that second license further includes identification information of a first license corresponding to the second license, second key information, and an electronic

signature. Akiyama teaches using digital signatures to secure the transportation of licenses (0107). Akiyama goes on to teach why using digital signature secures a transaction from alteration (0113). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine this feature to the licenses of Revital to ensure the licenses are not altered. Akiyama teaches a system whereby a first control information [first license] can be updated by a second control information [second license] which includes identifying information of the first license in order to update it as needed. Akiyama's second control information includes an identifier which specifies the first license and its information. It specifies the first license, so that it can be used to replace certain elements of the first license (0103). Specifically it can change permissions of the subscriber and the decryption keys. Akiyama system also allows for the updating of license information over an out of band channel to greater increase the systems security. Substituting known methods into similar system which yield predictable results if within the ordinary capabilities of the one of ordinary skill in the art. Using out of band updates to licenses improves the security of the system and integrates well with Revital's system. Revital teaches remotely renewing security elements without the need for physical proximity. Sending the renewable security elements through a phone line is one way of performing this feature without the need to a physical security element proximate to the receiver.

As per claim 3, Revital teaches that during the manufacturer of the recipient module an embedded key is stored in the hardware (col. 4, lines 38-42). Revital also teaches that any method of suitable encryption mechanism may be used for encrypting

the various types of keys in his invention (col. 9, lines 52-53). Even though Revital does not explicitly call any of the secret keys, public-keys, it would be obvious to one of ordinary skill in the art that public key cryptography could easily be used in this case.

The private stored key in the device would be the device's own unique private key.

Then, any entity who wishes to create a session key (as taught by Revital and Akiyama) would simply encrypt the session key with the device's public key so only that specific device could decrypt the message and obtain the session key. Revital even teaches encrypting one key with another. Akiyama teaches public key cryptography as means of transmitting license information (0111). This is a well established algorithm of key exchange. Anyone of ordinary skill in the art would readily use this algorithm. Therefore it would have obvious to one of ordinary skill in the art at the time of the invention to use the well known public key cryptography as a suitable encryption mechanism as Akiyama teaches.

As per claim 4, Revital teaches the second key included in the second license is encrypted and the control means decrypts, by using the first key information, encrypted second key information and uses the second key information to decrypt the acquired content (col. 5, lines 10-16).

As per claim 5, Revital teaches license management means for allowing any other information processing apparatus [plural recipient modules] to permit utilization of the contents when the utilization condition prescribed by the first license and the utilization condition prescribed by the second license are both satisfied (col. 5, lines 31-34).

As per claim 6, Revital teaches wherein in the case where plural contents [multiple portions or items of protected content] are distributed via the one channel successively in terms of time (col. 12, lines 11-13), the second acquisition means serves to acquire, during distribution of the first contents, the second license [second layer] which prescribes utilization condition [assess to particular items or portions] of second contents distributed subsequently to first contents, and the control means controls output of the second contents so that the second contents are outputted subsequently to the first contents in the case where the utilization condition prescribed by the first license and the utilization condition prescribed by the second license which prescribes the utilization condition of the second contents, which has been acquired by the second acquisition means, are both satisfied (col. 16, lines 15-24).

As per claim 9, Revital teaches when a plurality of contents [multiple portions or items of protected content] are distributed via the one channel successively in terms of time (col. 12, lines 11-13), the second acquisition means serves to acquire, during distribution of the first contents, the second license [second layer] which prescribes utilization condition [assess to particular items or portions] of second contents distributed subsequently to first contents, and the control means controls output of the second contents so that the second contents are outputted subsequently to the first contents in the case where the utilization condition prescribed by the first license and the utilization condition prescribed by the second license which prescribes the utilization condition of the second contents, which has been acquired by the second acquisition

means, are both satisfied (col. 16, lines 15-24).

As per claim 7, Revital teaches a method of processing content provided by a contents distribution service having a channel for distributing a plurality of available content (col. 10, lines 5-7), the method comprising:

a first acquisition step of acquiring a first license [first layer] having a utilization condition [access to protected content] applied in common for the plurality of available content, the first license further including first key information (col. 5, lines 5-7 and col. 10, lines 10-15);

a second acquisition step of acquiring, among the plurality of available contents, a second license [second layer], that has a utilization condition [assess to particular items or portions] for the acquired content (col. 5, lines 9-10);

an output step of playing the acquired content to a user when the utilization condition prescribed by the first and second license are both satisfied [properly decrypted] (col. 5, lines 35-37).

Revital is silent in explicitly disclosing the first license has a digital signature and that second license further includes identification information of a first license corresponding to the second license, second key information, and an electronic signature. Akiyama teaches using digital signatures to secure the transportation of licenses (0107). Akiyama goes on to teach why using digital signature secures a transaction from alteration (0113). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine this feature to the licenses

of Revital to ensure the licenses are not altered. Akiyama teaches a system whereby a first control information [first license] can be updated by a second control information [second license] which includes identifying information of the first license in order to update it as needed. Akiyama's second control information includes an identifier which specifies the first license and its information. It specifies the first license, so that it can be used to replace certain elements of the first license (0103). Specifically it can change permissions of the subscriber and the decryption keys. Akiyama system also allows for the updating of license information over an out of band channel to greater increase the systems security. Substituting known methods into similar system which yield predictable results if within the ordinary capabilities of the one of ordinary skill in the art. Using out of band updates to licenses improves the security of the system and integrates well with Revital's system. Revital teaches remotely renewing security elements without the need for physical proximity. Sending the renewable security elements through a phone line is one way of performing this feature without the need to a physical security element proximate to the receiver.

As per claim 8, Revital teaches a computer readable medium comprising a method of processing content provided by a contents distribution service having a channel for distributing a plurality of available content (col. 10, lines 5-7), the method comprising:

a first acquisition step of acquiring a first license [first layer] having a utilization condition [access to protected content] applied in common for the plurality of available

content, the first license further including first key information (col. 5, lines 5-7 and col. 10, lines 10-15);

 a second acquisition step of acquiring, among the plurality of available contents, a second license [second layer], that has a utilization condition [assess to particular items or portions] for the acquired content (col. 5, lines 9-10);

 an output step of playing the acquired content to a user when the utilization condition prescribed by the first and second license are both satisfied [properly decrypted] (col. 5, lines 35-37).

 Revital is silent in explicitly disclosing the first license has a digital signature and that second license further includes identification information of a first license corresponding to the second license, second key information, and an electronic signature. Akiyama teaches using digital signatures to secure the transportation of licenses (0107). Akiyama goes on to teach why using digital signature secures a transaction from alteration (0113). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine this feature to the licenses of Revital to ensure the licenses are not altered. Akiyama teaches a system whereby a first control information [first license] can be updated by a second control information [second license] which includes identifying information of the first license in order to update it as needed. Akiyama's second control information includes an identifier which specifies the first license and its information. It specifies the first license, so that it can be used to replace certain elements of the first license (0103). Specifically it can change permissions of the subscriber and the decryption keys. Akiyama system also

allows for the updating of license information over an out of band channel to greater increase the systems security. Substituting known methods into similar system which yield predictable results if within the ordinary capabilities of the one of ordinary skill in the art. Using out of band updates to licenses improves the security of the system and integrates well with Revital's system. Revital teaches remotely renewing security elements without the need for physical proximity. Sending the renewable security elements through a phone line is one way of performing this feature without the need to a physical security element proximate to the receiver.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL R. VAUGHAN whose telephone number is (571)270-7316. The examiner can normally be reached on Monday - Thursday, 7:30am - 5:00pm, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. R. V./

Examiner, Art Unit 2431

/Syed Zia/

Primary Examiner, Art Unit 2431

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